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EXAMINER

KALINOWSKI, A

ART UNIT

PAPER NUMBER

2166

DATE MAILED:

11/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/010,919

Applicant(s)
Ordish et al

Examiner
Alexander Kalinowski

Group Art Unit
2166

☒ Responsive to communication(s) filed on Mar 21, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 43-117 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 43-49, 52, 54, 55, 59, 60, 62-74, 77, 79, 80, 84, 85, 87-99, 102, 104, 1 is/are rejected.

☒ Claim(s) 50, 51, 53, 56-58, 61, 75, 76, 78, 81-83, 86, 100, 101, 103, 106-108, a is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Claims 43-117 are presented for examination. Applicant filed a terminal disclaimer on 3/21/00. Therefore, the Examiner withdraws the nonstatutory double patenting rejection of claims 43-117. However, the Examiner conducted a new search for prior art and new grounds of rejection are established in the instant office action below.

Terminal Disclaimer

2. The terminal disclaimer filed on 2/25/00 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 5,727,165 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Specification

3. The disclosure is objected to because of the following informalities: the specification contains a section of background information and a drawing which do not seem to belong in the specification. These materials are found on pages 1-5 of the specification. The Examiner notes that the materials seem to have been inadvertently attached to the original specification of Pat. No. 5,727,165. However, if the descriptive material and drawing figure were meant to be incorporated within the specification, the Examiner refers Applicants to the next section below describing the proper arrangement of a specification.

Appropriate correction is required.

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The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to "Microfiche Appendix" and the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-References to Related Applications.
- © Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Microfiche Appendix" (see 37 CFR 1.96).
- (e) Background of the Invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).

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- (h) Detailed Description of the Invention.
- (I) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing (see 37 CFR 1.821-1.825).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 43-45, 48, 49, 52, , 54, 59, 62-70, 73, 74, 77, 79, 80, 84, 87-95, 98, 99, 104, 109, and 112-117 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverman et al., Pat. No. 5,136,501 (hereinafter Silverman).

With respect to claim 43, Silverman discloses a system for exchanging signals relating to at least a bid and an offer (see abstract), the system comprising:

a network (unit 22) connected to workstations, units (26a) and (26b) (Fig. 1) ;

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a first workstation (unit 24a) of said workstations, said first workstation sending a first signal to said network signaling a bid in response to an initial offer (i.e. trader decides to enter a bid or enter an offer in an effort to complete matching a transaction. Key station 24a submits bid transaction to central system 20)(see Fig. 6 and col. 14, line 60 - col. 15, line 6);

a second workstation of said workstations, said second workstation receiving a second signal indicative of said bid from said network (Directed Msg. B) and for sending an acknowledgment of said received bid to said network (Directed Msg.-Ack B)(i.e. directed message sent to the counterparty workstations and associated directed message acknowledgment) and (see Fig 6 and col. 15, lines 36-43 and lines 56-60)

said network sending at least a third signal to said first workstation and at least a fourth signal to said second workstation, said at least third and said at least fourth signals indicating acknowledgment of said acknowledgment from said second workstation (i.e. the system generates directed messages to the counterparties, the associated directed message acknowledgments and the IXM update broadcast message 132 to all keystations 24 including 24a and 24b)(col. 15, lines 36-42 and col. 16, lines 1-8).

With respect to claim 44, Silverman discloses the system according to claim 44, wherein said at least third signal includes a first purchase confirmation signal and said at least fourth signal includes a second purchase confirmation signal (i.e. broadcast message to all workstations 24)(col. 15, lines 36-42 and col. 16, lines 1-8).

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With respect to claim 45, Silverman discloses the system according to claim 43, further comprising at least one storage node for recording the completion of a purchase relating to said bid (i.e order database 114 and 116)(col. 13, lines 14-26).

With respect to claim 48, Silverman discloses the system according to claim 43, said network generating and transmitting an acknowledgment of the receipt of the first signal (i.e. CMD-Ack 122)(Fig. 6).

With respect to claim 49, Silverman discloses the system according to claim 48, wherein said acknowledgment of the receipt of said first signal and said second signal indicative of said bid are match notification signals (directed Msg. A 124 and Directed Msg. B 128) generated by at least one computer unit 20 in said network (see Fig. 6).

With respect to claim 52, Silverman discloses the system according to claim 43, wherein said network further comprises:

a computer for matching bids and offers from said workstations in accordance with predetermined matching criteria (i.e. the central system 20 validates the transaction request and attempts to find matches between this new entry and other bids and offers posted in the system book subject to counterparty credit limits)(col. 7, lines 5-13).

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With respect to claim 54, Silverman discloses a method for acknowledging the receipt signals relating to bids and offers in an electronic trading system, said electronic trading system including a network and at least first and second workstations coupled to a network (see abstract and Fig. 6), the method comprising the steps of:

 sending an offer from the first workstation to the network in response to an initial bid (i.e. trader decides to enter a bid or enter an offer in an effort to complete matching a transaction. Key station 24a submits bid transaction to central system 20)(see Fig. 6 and col. 14, line 60 - col. 15, line 6);

 receiving the offer from said network at the second workstation (i.e. directed Msg. B 128)(Fig. 6);

 sending from the second workstation to said network an acknowledgment of the receipt of the offer (i.e. Directed Msg.-Ack B)(Fig. 6); and

 sending from the network to the first and second workstations an indication that the network acknowledges the acknowledgment from said second workstation (i.e. Broadcast Msg. 132)(Fig. 6).

With respect to claim 59, Silverman discloses a computer-readable medium having computer-executable instructions for performing steps (see abstract, Fig. 1 and Fig. 6)comprising:

 receiving at a networked processor an offer from a first workstation in response to an initial bid (i.e. trader decides to enter a bid or enter an offer in an effort to complete matching a

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transaction. Key station 24a submits bid transaction to central system 20)(see Fig. 6 and col. 14, line 60 - col. 15, line 6);

sending the offer from the networked processor to a second workstation (i.e. directed Msg. B 128)(Fig. 6);

receiving an acknowledgment of a transaction based on the offer from the second workstation at the networked processor (i.e. Directed Msg.-Ack B)(Fig. 6); and

sending from the networked processor to the first and second workstations an indication that the networked processor received the acknowledgment of the transaction (i.e. Broadcast Msg. 132)(Fig. 6).

With respect to claim 62, Silverman discloses a workstation participating in the exchange of signals, the signals including at least a bid and an offer, the workstation connected to a network, said network connected to at least a second workstation (see abstract and Fig. 1), said workstation comprising:

a receiver unit 24a for receiving an initial offer (i.e. trader can decide whether to enter a bid or enter an offer in an effort to complete matching a transaction) (see Fig. 6 and col. 6, line 61 -col. 7, line 2);

a processor unit 20 for processing said initial offer (col. 7, lines 5-13);

an output for outputting a first signal to said network, said first signal signaling a bid in response to said initial offer (i.e. trader decides to enter a bid or enter an offer in an effort to

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complete matching a transaction. Key station 24a submits bid transaction to central system 20)(see Fig. 6 and col. 14, line 60 - col. 15, line 6);

said receiver also receiving a second signal wherein said second signal indicates the acknowledgment of a receipt of said first signal by said second workstation (i.e. Broadcast Msg 132)(Fig. 6).

With respect to claim 63, Silverman discloses a computer-readable medium having computer-executable instructions for performing steps associated with a purchase comprising a bid and an offer (see abstract and Fig. 1) comprising:

transmitting to a network an offer from a first workstation in response to a received initial bid (i.e. trader can decide whether to enter a bid or enter an offer in an effort to complete matching a transaction) (see Fig. 6 and col. 6, line 61 -col. 7, line 2); and

receiving an acknowledgment from said network indicating that a workstation originating said initial bid has acknowledged said transmitted offer (i.e. Broadcast Msg 132)(Fig. 6).

With respect to claim 64, Silverman discloses the computer readable medium according to claim 63, having further computer readable instructions comprising the step of:

processing said acknowledgment as an acceptance of said transmitted offer (i.e. broadcast Msg 132)(Fig. 6).

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With respect to claim 65, Silverman discloses the system according to claim 43, wherein said third signal and said fourth signal indicate that a transaction relating to said bid is complete (i.e. Broadcast Msg. 132)(Fig. 6).

With respect to claim 66, The method according to claim 54, wherein the indication that the network acknowledges the acknowledgment from said second workstation signifies the completion of a transaction relating to said bid (i.e. Broadcast Msg. 132)(Fig. 6).

Claims 67, 68, 79, 84, 87, 88, 92, 93, 104, 109, 112, 113 and 117 are similar in scope to claims 43, 54, 59, 62, 63, and 67 and are rejected on the same basis.

Claims 69, 70, 73, 74, 77, 89, 90, 91, 94, 95, 98, 99, and 114-116 recite the substantially the same limitations as claims 44, 45, 48, 49, 52, 64-66 and the claims are rejected on the same basis.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 46, 47, 55, 60, 71, 72, 80, 85, 96, 97, 105 and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al., Pat. No. 5,136,501.

With respect to claim 46, Silverman discloses the system according to claim 43.

Silverman does not explicitly disclose wherein prior to the transmission of said first signal by said first workstation, said second workstation transmits said initial offer to said network.

However, Silverman does disclose a user of a first workstation decides to enter a bid or enter an offer in an effort to complete matching a transaction (col. 6, lines 61-63). Since the system matches the bid or offer of the user of the first workstation with the initial bid or offer of the second workstation, the user of the first workstation could have entered a bid or offer in response to the initial bid or offer of the user of the second workstation. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein prior to the transmission of said first signal by said first workstation, said second workstation transmits said initial offer to said network within the Silverman system since the first workstation submits a bid or response in an effort to complete a matching transaction (col. 6, lines 61-63).

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With respect to claim 47, Silverman does not explicitly disclose the system according to claim 46, said network generating and transmitting an acknowledgment of said initial bid to said second workstation.

However, Silverman does disclose the network generating and transmitting an acknowledgment of the first workstation sending a first signal to said network signaling a bid in response to an initial offer (see Fig. 6, CMD-ACK 122). The purpose of the acknowledgment signal is for the network to acknowledge receipt of a transaction signal from the first workstation (col. 8, lines 42-45). Although Silverman does not explicitly disclose a command acknowledgment of the initial transactional signal from the second workstation, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the system according to claim 46, said network generating and transmitting an acknowledgment of said initial bid to said second workstation within Silverman in order to acknowledge receipt of a transactional message from the second workstation (col. 8, lines 42-45).

With respect to claim 55, Silverman does not explicitly disclose the method according to claim 54, further comprising the steps of:

sending the initial bid from the second workstation to the network.

However, Silverman does disclose a user of a first workstation decides to enter a bid or enter an offer in an effort to complete matching a transaction (col. 6, lines 61-63). Since the system matches the bid or offer of the user of the first workstation with the initial bid or offer of

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the second workstation, the user of the first workstation could have entered a bid or offer in response to the initial bid or offer of the user of the second workstation. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include sending the initial bid from the second workstation to the network within the Silverman system since the first workstation submits a bid or response in an effort to complete a matching transaction (col. 6, lines 61-63).

Silverman does not explicitly disclose

receiving an acknowledgment of the initial bid from the network at the second workstation.

However, Silverman does disclose the network generating and transmitting an acknowledgment of the first workstation sending a first signal to said network signaling a bid in response to an initial offer (see Fig. 6, CMD-ACK 122). The purpose of the acknowledgment signal is for the network to acknowledge receipt of a transaction signal from the first workstation (col. 8, lines 42-45). Although Silverman does not explicitly disclose a command acknowledgment of the initial transactional signal from the second workstation, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the system according to claim 46, said network generating and transmitting an acknowledgment of said initial bid to said second workstation within Silverman in order to acknowledge receipt of a transactional message from the second workstation (col. 8, lines 42-45).

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With respect to claim 60, Silverman does not explicitly disclose the computer-readable medium of claim 59 having further computer-executable instructions for performing the following steps:

receiving at the networked processor the initial bid from the second workstation.

However, Silverman does disclose a user of a first workstation decides to enter a bid or enter an offer in an effort to complete matching a transaction (col. 6, lines 61-63). Since the system matches the bid or offer of the user of the first workstation with the initial bid or offer of the second workstation, the user of the first workstation could have entered a bid or offer in response to the initial bid or offer of the user of the second workstation. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include receiving at the networked processor the initial bid from the second workstation within the Silverman system since the first workstation submits a bid or response in an effort to complete a matching transaction (col. 6, lines 61-63).

Silverman does not explicitly disclose

sending an acknowledgment of the initial bid from the networked processor to the second workstation.

However, Silverman does disclose the network generating and transmitting an acknowledgment of the first workstation sending a first signal to said network signaling a bid in response to an initial offer (see Fig. 6, CMD-ACK 122). The purpose of the acknowledgment signal is for the network to acknowledge receipt of a transaction signal from the first workstation

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(col. 8, lines 42-45). Although Silverman does not explicitly disclose a command acknowledgment of the initial transactional signal from the second workstation, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the system according to claim 46, said network generating and transmitting an acknowledgment of said initial bid to said second workstation within Silverman in order to acknowledge receipt of a transactional message from the second workstation (col. 8, lines 42-45).

Claims 71, 72, 80, 85, 96, 97, 105 recite the substantially the same limitations as claims 46, 47, 55 and are rejected on the same basis.

Allowable Subject Matter

8. Claims 50, 51, 53, 56-58, 61, 75, 76, 78, 81-83, 86, 100, 101, 103, 106-107 and 111 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.